

RESPONSE TO OFFICE ACTION

This responds to the Office Action issued on September 11, 2019 wherein the Examining Attorney has refused registration of the applied-for mark under Sections 1, 2 and 45 of the Trademark Act. Specifically, the Examining Attorney has refused registration “because the applied-for mark as used on the specimen of record is merely a decorative or ornamental feature of applicant’s clothing and, thus, does not function as a trademark to indicate the source of applicant’s clothing and to identify and distinguish applicant’s clothing from others.” The Examining Attorney goes on to state that since “the submitted specimen shows the applied-for mark, THE, located directly on the upper-center area of the front of the shirt and the front portion of the hat, where ornamental elements often appear,” coupled with the fact that “the mark is displayed in a relatively large size on the clothing such that it dominates the overall appearance of the goods”, the applied-for mark would be perceived by consumers as having little or no particular source-identifying significance – i.e., it is merely ornamental.

Applicant respectfully disagrees with the Examining Attorney. While the cases cited by the Examining Attorney may be appropriate for cases wherein the Applicant is the manufacturer or the producer of the apparel itself, such as the case with a fashion designer, those cases are inapposite in scenarios such as here, where the Applicant is a service provider for university level educational and athletic services as the case herein – i.e., the Applicant is not an apparel manufacturer or producer. Indeed, this is a case where the applied-for mark, namely THE (the “Applied-for Mark”), when used in connection with clothing apparel, is an indicator of secondary source and sponsorship. Therefore, the Applied-for Mark is not merely ornamental and is worthy of federal trademark registration.

In order to assist the Examining Attorney in her examination of the Applied-for Mark, Applicant will present the history of the formation, adoption, and use of the Applied-for Mark, so that the Examining Attorney can understand the relevance of the Applied-for Mark to the Applicant's very founding, its history, and the resulting organic adoption of its use by students, athletes, fans, and alumni of The Ohio State University to not only identify the university and its services, but to serve as an indication of secondary source when applied to apparel, accessories, and other novelty items. Applicant will also present evidence in the form of unsolicited statements from third parties that support Applicant's claim that the Applied-for Mark has come to be associated with The Ohio State University in the context of university level educational and athletic services. Applicant further supports its position with the Declaration of Richard VanBrimmer, Assistant Vice President, Business Advancement, Affinity & Trademark Management at The Ohio State University (the "VanBrimmer Dec.").

The Ohio State University's Academic and Athletic Programs

Applicant is The Ohio State University (hereinafter referred to as "Ohio State" or "Applicant"). For over 150 years, Applicant has provided college level educational courses, sponsored collegiate sporting events and recreation programs, staged dramatic and musical entertainment events, and provided cutting edge research and development in many fields, including but not limited to medicine, life sciences, arts, agriculture, and engineering. VanBrimmer Dec. at ¶ 2. Indeed, Ohio State has a long tradition of academic excellence, and its reputation is nationally known. Id. It's undergraduate program and graduate programs for law, medicine, business, engineering, and education are all currently ranked among the top 40 schools in the nation in their respective areas by U.S. News & World Report. Id. More than 60,000

students were enrolled at Ohio State's main campus for the 2019 Autumn Semester, and Ohio State has 550,000 living alumni. Id. at ¶¶ 7, 8.

Applicant's athletic programs have a long history of success. Id. at ¶ 7. Applicant is a member of the Big Ten athletic conference and the National Collegiate Athletic Association. Id. at ¶ 3. Ohio State is among only five universities with NCAA championships in baseball, basketball and football, and has also won national championships in men's swimming and diving, men's outdoor track and field, men's golf, men's gymnastics, men's fencing, co-ed fencing, synchronized swimming, and men's volleyball. Id. at ¶ 10. Ohio State's athletic teams enjoy a long and proud tradition of excellence in interscholastic athletic competition and an enthusiastic and loyal following. Id. at ¶¶ 3, 4, 10.

This enthusiasm and loyalty to Ohio State has traditionally been at its peak during the Ohio State football season each fall and winter, though this enthusiasm and loyalty remains strong for all Ohio State athletic programs. Id. at ¶ 4. On average, over 100,000 people attend each Ohio State home football game at Ohio Stadium and approximately 16,000 people attend each Ohio State home men's basketball game at the Schottenstein Center. Id. For many years, the demand for tickets to these games has exceeded the available supply. Id. Ohio State receives substantial coverage by local, regional and national media, including the national broadcast of certain Ohio State football and basketball games. Id. at ¶ 10. Applicant's football team has won the National Championship in football eight (8) times, with its latest championship in 2014, and Ohio State's appearance in national championship and major bowl games is viewed by tens of millions each year in widely viewed, nationally televised games. Id. In the last sixteen years, the Ohio State

football team has won ten Big Ten Football Championships¹. Id. In addition, the Ohio State basketball team has enjoyed fourteen twenty-win seasons in the last fifteen years. Id.

The Ohio State University's Trademark and Licensing Program

Ohio State owns numerous trademarks for its names, logos, and slogans used in connection with Ohio State and its athletic teams, including the “Block O” design, THE OHIO STATE UNIVERSITY, BUCKEYES, OSU, O-H-I-O, BRUTUS (the name of Ohio State’s beloved school mascot), as well as trade dress for its colors and logos, including in connection with its football uniforms (collectively “Ohio State Marks”). Id. at ¶ 6. Ohio State licenses and markets many items bearing the Ohio State Marks that have come to symbolize the goodwill and reputation of Ohio State and its services. Id. at ¶ 9. Some of these trademarks were created out of targeted marketing campaigns or otherwise; others were borne organically and from the culture of Applicant’s students, athletes, and alumni that make up the membership of Ohio State. Id. While trademarks like THE OHIO STATE UNIVERSITY fit this former category, the Applied-for Mark, namely THE, fits this latter category. Id.

The success of Ohio State as an academic and athletic powerhouse has cemented the presence of Ohio State and the Ohio State Marks on a national stage—making goods bearing Ohio State trademarks even more sought after and desired. Id. at ¶ 11. Ohio State’s licensing revenues are consistently in the millions each year and continue to soar, averaging over \$12.5 million a year over the last 10 years (including over \$15.5 million dollars in (fiscal year) 2019). Id. Many fans and other supporters of Ohio State’s athletic teams, and particularly many of those fortunate enough to attend these games in person, demonstrate their support for Applicant by wearing apparel bearing one or more of the Ohio State Marks and/or purchasing items bearing Ohio State

¹ Ohio State vacated its 2010 Big Ten Football Championship.

Marks for family members, friends, and business associates – including goods bearing the Applied-for Mark, namely THE. Id. Indeed, from 2002 to date, Ohio State has earned over \$181 million in royalties from licensing Ohio State Marks – money that is then reinvested into the university and its numerous missives, including but not limited to student scholarships, libraries, teaching, research, and athletics. Id.

Evolution of Emphasis on “The”

The use and emphasis of “The” has been an integral and important part of the very identity of Applicant since its infancy. Applicant’s predecessor in interest, known as Ohio Agricultural & Mechanical (“Ohio A&M”) was founded in 1870 under the Morrill Act. Id. at ¶ 1. In its early years, the name “Ohio A&M” was thought by some as inadequate to represent the institution that was the only beneficiary of the land grant act in Ohio and campaigned for a new name that could separate Applicant from other colleges. Id. Applicant’s name was thereafter changed to “The Ohio State University” in 1878, with legend having it that the use of “The” (as opposed to the addition of “An” or nothing – i.e., “Ohio State University”) was to make clear that Applicant was supposed to be the leader in the state:

The “The” was actually part of the state legislation when the university was renamed in 1878. The following excerpt is from the Board of Trustee minutes: “...the educational institution heretofore known as the ‘Ohio Agricultural and Mechanical College,’ shall be known and designated hereafter as ‘The Ohio State University.’” Those who wanted the name change thought the original name was too narrow in scope, and that it was inadequate for the institution that was the only beneficiary of the land grant act. President Edward Orton was insistent that a new name would separate the institution from other colleges in Ohio. Legend also has it that “The” was used to show the other colleges which institution was supposed to be the leader in the state – both in size and in financial support from the legislature.

Id. Over time, the term “THE” in The Ohio State University began to be prominently emphasized when spoken. Id. at ¶¶ 13, 14.

While it is difficult to pinpoint the exact date when “The Ohio State University” began to be pronounced with a prominent and elongated emphasis on *THE*, most who read this will recite in their minds or out loud – *THE* Ohio State University – pronounced with a long “ee” vowel, rather than a short “uh.” *Id.* at ¶ 13. Some credit former Ohio State football player Robert Smith as the originator of this emphasis, who in 1994 announced on Monday Night NFL Football that he was from “*THE* Ohio State University.” *Id.* But even Robert Smith recounts that it was not his creation, but rather something that was just a part of the culture of Ohio State. *Id.* Some point to former President Gordon Gee who, in his speech to the graduating class of 1992, encouraged those graduates to go out and “let them know that you graduated from THE Ohio State University.” *Id.* Some look more formulaically to the evolution of Applicant’s branding and its desire in the late 1980’s to move away from being known as solely as an “OSU.” *Id.* Practically speaking, however, these factors highlight the fact that the use of “The” in “The Ohio State University” was always intentional and purposeful, which led, over time, to the organic desire amongst students, athletes, alumni, and fans of Ohio State to proudly state that they are a member of, fan of, or belong to “*THE* Ohio State University.” *Id.* at ¶ 14. Hence, the birth of the Applied-for Mark as shorthand for The Ohio State University and the demand for apparel bearing the Applied-for Mark. *Id.*

The Applied-for Mark is an Indicator of Secondary Source

As explained above, Applicant is not an apparel producer or manufacturer; rather it is a long-standing and highly recognized provider of educational, research, and athletic programs and services. Thus, its trademarks are licensed to third parties for the production or manufacture of apparel and other novelty items to in turn be offered to the fans, students, and alumni of The Ohio State University and its educational and athletic programs. In turn, the fans, students, and alumni of The Ohio State University purchase apparel bearing Ohio State Marks, including THE, because

it serves *secondary source* indication or sponsorship – i.e., it is not the message on the sewn-in label that matters, it is the message on the apparel itself. *Id.* at ¶ 16.

It is well-settled that a mark that “serves as a part of the aesthetic ornamentation of goods, such as clothing items, may be registered as a trademark, if it also serves a source-indicating function.” *In Re Dr. Ing. h.c. F. Porsche AG*, 2002 WL 732144, at *2 (T.T.A.B. Apr. 24, 2002) (emphasis added) (quoting *In re Pro-Line Corp.*, 28 U.S.P.Q.2d 1141 (T.T.A.B. 1993)); *see also In re Dimitri's Inc.*, 9 U.S.P.Q.2d 1666 (T.T.A.B. 1988). Ornamental matter serves as a source-indicator, for example, if it “names the secondary source of the goods or if, it is already a recognized trademark of applicant for other goods or services.” *In Re Dr. Ing. h. c. F. Porsche AG*, 2002 WL 732144, at *2.

In re Olin Corp., 181 U.S.P.Q. 182 (T.T.A.B. 1973), involved the Board’s reversal of an examiner’s refusal to register a mark comprising of a stylized letter O (Olin’s corporate logo) for use on clothing. As the Board said in reversing the examiner for refusing to pass the stylized “O” for T-shirts on to publication:

The “ornamentation” of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name “New York University” and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-shirt will also advise the purchaser that the university is the secondary source of that shirt. It is not imaginable that Columbia University will be the source of an N.Y.U. T-shirt. Where the shirt is distributed by other than the university the university's name on the shirt will indicate the sponsorship or authorization by the university.

The decision in *In re Olin* is not an anomaly. The United States Patent and Trademark Office has long recognized that the logos and names of sports teams can be registered on the

principal registry for what would otherwise be ornamental use on clothing. “A mark appearing on collegiate or professional sports teams’ merchandise such as hats and shirts usually serves as an indication of secondary source; ***it refers to or identifies the school or the team itself.***” *Univ. of S. California v. The Univ. of S. Carolina*, 2008 WL 3333839, at *11 (T.T.A.B. Aug. 1, 2008) (emphasis added). Consumers purchase and wear clothing with logos and names of collegiate and professional sports teams because of the ornamental presence of the secondary source mark. *Id.* Thus, the purpose of the purchase is not to acknowledge the manufacturer of the goods. In short, “[t]he decision to purchase arises from the purchaser’s desire to demonstrate his or her connection to or affiliation with the secondary source (the school, or the team)...” *Id.*

Of course, while evidence of the Applied-for Mark serving as a secondary source indicator is found in Applicant’s own history and archives, there are numerous unsolicited articles, blogs, posts, and comments that recognize the Applied-for Mark as having secondary source indication or sponsorship. VanBrimmer Dec. at ¶ 15. Some excerpts follow below:

Other universities have tried (and some succeed) at adding a “the” to their names, like The University of Texas and a whole host of state flagship universities. In fact, the University of Miami is often referred to by its unofficial nickname of “The U.” **However, there’s really no other case where the is so closely tied to a college’s identity than at The Ohio State University** (emphasis added).

If you’re a college football fan or a fan of college sports, in general, it’s safe to say that you’ve probably heard someone refer to Ohio State as “THE Ohio State University”. Why is this? It’s not like we say “THE Florida State University” or “THE University Of North Carolina” or “THE” anything else for that matter (emphasis added).

OSU has won eight national championships and 37 Big Ten titles, completing 10 undefeated seasons. In 2017, the *Wall Street Journal* valued the program at \$1.5 billion dollars, the highest in the nation. **This level of singular football success has led to a self-proclaimed title as not just “an” Ohio State University but, particularly in the world of football, THE Ohio State University.** What’s more, the formulation of this term and the phrase is precise and formulaic—it’s pronounced with a long “ee” vowel, rather than a short “uh,” emphasized more than

the words “Ohio State” and always, always capped with the term “University” ... **Any football fan could tell you, as soon as they hear “thee,” pronounced in that fastidious patois, that we’re talking about Ohio State** (emphasis added).

The word THE superimposed on the shape of the state of Ohio, in scarlet and gray, instantly calls to mind Ohio State. For some reason I have never grasped, Buckeyes like to refer to their school as THE Ohio State University, with huge emphasis on the word “the.” **This is particularly noticeable at the beginning of NFL football games, when former OSU players always introduce themselves as, for example, “Ezekiel Elliott, THE Ohio State University”** (emphasis added).

The Ohio State University fans feel very strongly about the "the" (emphasis added).

The school is officially known as "The Ohio State University," and **the article at the beginning of the name has become a point of pride** for students, alumni and fans of the Ohio State Buckeyes (emphasis added).

Ohio State University, home of Buckeyes, applies to trademark the word 'the'. The application requests a standard character trademark for the title “The Ohio State University”, which was the school’s former name and **is often used by students and fans of its athletic teams.** It would cover various items including t-shirts, baseball caps and hats. The trademark would be seen as particularly valuable due to Ohio State’s popular college football team (emphasis added).

Id. While there is no doubt that the students, alumni, and fans of The Ohio State University understand the Applied-for Mark points to The Ohio State University, there is no greater evidence of secondary source indication than by those who are not members of that source - i.e., it is widely known that THE is shorthand for The Ohio State University and that THE points to Ohio State and its academic missives and athletic services.

Again, the Ohio State Marks – including the Applied-for Mark – that appear on collegiate merchandise such as hats and shirts, serves as an indication of secondary source; it refers to or identifies The Ohio State University and/or the “Buckeyes” athletic teams; that the decision to purchase apparel bearing Ohio State Marks – including the Applied-for Mark – arises from the purchaser’s desire to demonstrate his or her connection to, affinity for, or affiliation with the secondary source, namely The Ohio State University. This is one of the prevailing reasons why

the sale of counterfeit and otherwise unauthorized or unlicensed goods is an enforcement issue for Ohio State. *Id.* at ¶ 16.

Indeed, unauthorized and unlicensed merchandise prominently bearing Ohio State Marks – including the Applied-for Mark – have been found to be offered for sale during times when the relevant purchasing public has a heightened sense of affinity for Ohio State and will be more likely to make purchases on impulse, such as the area immediately surrounding Ohio Stadium during home football games. *Id.* Moreover, Ohio State takes its obligation to protect its trademarks from being used to confuse the public quite seriously, and is further motivated to ensure that the revenue from the sale of merchandise bearing the Ohio State Marks, including the Applied-for Mark, purchased by fans, students, and alumni to show affinity for Ohio State, actually makes its way to serving the greater interests of The Ohio State University in all its missives, including but not limited to student scholarships, libraries, teaching, research, and athletics. *Id.* at ¶ 16, 17. Thus, as with its other requests for federal trademark protection of its trademarks and trade dress on apparel, Ohio State has requested federal trademark protection for the Applied-for Mark, namely THE, to protect its loyal customer fan base from the prevalence of counterfeit apparel. *Id.*

In conclusion and as previously submitted, the United States Patent and Trademark Office has long recognized that the logos and names of sports teams can be registered on the principal registry for what would otherwise be ornamental use on clothing. “A mark appearing on collegiate or professional sports teams’ merchandise such as hats and shirts usually serves as an indication of secondary source; it refers to or identifies the school or the team itself.” *Univ. of S. California v. The Univ. of S. Carolina*, 2008 WL 3333839, at *11 (T.T.A.B. Aug. 1, 2008). Consumers purchase and wear clothing with logos and names of collegiate and professional sports teams because of the ornamental presence of the secondary source mark. *Id.* Thus, the purpose of the

purchase is not to acknowledge the manufacturer of the goods. In short, “[t]he decision to purchase arises from the purchaser’s desire to demonstrate his or her connection to or affiliation with the secondary source (the school, or the team)....” *Id.* Applicant respectfully submits that this is the case herein, and that the Applied-for Mark, namely THE, serves as a secondary source and functions as an indicator of source and sponsorship in The Ohio State University. As such, Applicant requests that the Examining Attorney withdraw the merely ornamental refusal.

Prior-Filed Application Advisory

Without waiving any rights, claims, or remedies, Applicant hereby requests suspension of its application pending the outcome of the cited pending application Serial No. 88/416,806.